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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,148	04/26/2006	Tadashi Dojo	02910.103293.1	3336

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EXAMINER	
VAJDA, PETER L	
ART UNIT	PAPER NUMBER
1795	

MAIL DATE	DELIVERY MODE
03/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/577,148	DOJO ET AL.	
	Examiner	Art Unit	
	PETER L. VAJDA	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 April 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/11/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The applicant's reply filed 12/12/2008 has been received and considered. All claims remain as previously presented: claims 1-7 are pending and claims 8-9 are cancelled. After consideration of the applicant's remarks, all pending rejections are maintained and re-presented below, followed by a complete response to the applicant's arguments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-341598 (equivalent to Matsunaga *et al.* US PGP 2003-044708) in view of Sawada *et al.* (US PGP 2003/0039909) and considered with JP 06-118700.

This rejection was presented in the prior office action and is incorporated herein in its entirety. The rejection header has been modified to include claim 5 as being rejected herein as the omission was a typographical error in the prior action. The prior office action clearly pointed out that JP '598 taught that the magnetic body have a

particle size of from 0.1 to 0.5 micrometers, which is within the range taught by the applicant in pending claim 5.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-341598 (equivalent to Matsunaga *et al.* US PGP 2003-044708) in view of Sawada *et al.* (US PGP 2003/0039909) and considered with JP 06-118700 as applied to claims 1-4 and 6-7 above, and further in view of Ohtani *et al*. (US Patent 4789613).

This rejection was presented in the prior office action and is incorporated herein in its entirety.

Response to Arguments

Applicant's arguments filed 12/12/2008 have been fully considered but they are not persuasive. The applicant has argued that the dispersed state of the magnetic material must be controlled in order to achieve the dielectric loss tangent properties disclosed in pending claim 1 and has further argued that the dispersed state is an essential feature of the invention, but the pending claims do not recite that the magnetic material be dispersed nor the degree to which they need be dispersed in order to achieve the desired properties claimed and argued by the applicant. Therefore, the dispersion feature is not recited in the pending claims nor is it readily apparent that is obtained, such as in a product-by-process claim. If the applicant continues this line of

argument a 35 USC 112, first paragraph, enablement rejection could possibly be applicable.

The applicant also points to Comparative Examples 1, 2, and 4 of the present specification as exemplifying toners with insufficiently dispersed magnetic materials. The applicant, however, has not shown how these are commensurate in scope with the toners of JP '598. It should also be noted that there is no limitation in the pending claims requiring that the magnetic material be dispersed and it is only the claims that are to be considered for examination. As there is no limitation in the pending claims requiring that the magnetic material be dispersed it is maintained by the examiner that the pending rejections meet all the limitations of the pending claims and are proper. Furthermore, the applicant has not identified the parameters for a satisfactory dispersed state nor has the applicant identified how or why the toners of JP '598 do not possess such a dispersed state. Furthermore, the applicant argues that the teachings of JP '700 do not apply to toners comprising magnetic materials but offers no evidence to support this position. According to the MPEP, the arguments of council cannot take the place of fact and objective evidence must be factually supported. In order to be considered, any objective evidence must be accompanied by experimental data that corroborates the objective results (MPEP 716.01(c)).

The applicant further argues that JP '598 teaches amounts up to 200 parts magnetic material per 100 parts binder resin, which represents only the upper end of the range taught by JP '598. The lower end of the range is taught to be 20 parts magnetic material per 100 parts binder resin which is well within the applicant's range

(p. 7 [0095] of Matsunaga). The applicant also argues that the saturation magnetism taught by JP '598 is up to 200 Am^2/ka as contrasted with 20-35 Am^2/ka, however, JP '598 teaches a saturation magnetism of as low as 10 Am^2/ka.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER L. VAJDA whose telephone number is (571)272-7150. The examiner can normally be reached on 7:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/
Primary Examiner, Art Unit 1795

/PLV/ 03/11/2009